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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,439	03/07/2002	Kazuto Kunita	019519-354	9479

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT PAPER NUMBER

1752

DATE MAILED: 12/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

0203

<b>Office Action Summary</b>	<b>Application No.</b> 10/091,439	<b>Applicant(s)</b> KUNITA ET AL.	
	<b>Examiner</b> Cynthia Hamilton	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-12, 15-17 is/are allowed.
- 6) ☒ Claim(s) 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Claim 1 is objected to because of the following informalities: There is a period at the end of line 8 in the middle of claim 1 that needs to be removed. A claim is to be only one sentence. Appropriate correction is required.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.  $R^7$  is defined but where  $R^7$  is cannot be determined. Thus, claim 14 is indefinite. Further in lines 5-6 of claim 14,  $R^9$  is defined as "a substituent selected from the groups shown below". Since no clear "below" groups are set forth, it is unclear if only the alkyl group, having from 1-to 8 carbon atoms, the hydrocarbon group having not more than 12 carbon atoms and "an aromatic hydrocarbon group which may has a substituent" and "a dialkylmethylene group having not more than 12 carbon atoms" are the groups below as they are the only "groups" listed below or are the chemical structures below in claim 14 the "groups" below being referenced. Claim 14 is indefinite because there is no clear understanding what groups below for defining  $R^9$  encompass.

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5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 references a  $Z^{1-}$  but shows no such variable in the structure. Thus, reference to it being unnecessary sometimes is confusing.

6. Claims 1-12 and 15-17 would be allowed if the mid sentence period were removed from claim 1.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kunita (US 6,476,092 B1 or EP 1 091 247 A2) teach the use of the instant formula (I) compounds in lithographic plates imageable with infrared radiation for the reasons of storage stability. The use of these compounds in microcapsules is taught in col. 134 in the US and on page 13 of the EP document. There is no teaching of using the microcapsules in a lithographic printing plate. Kunita (US paragraph 0014) teach the presence of a substituted alpha position heteroatom or halogen atom aides in reducing the polymerization inhibition by oxygen being greatly reduced. Since Kunita has a separate inventive entity than that of the instant application, it is applicable prior art. Yanaka et al (2001/0046638 A1) teach similar compounds wherein X1 would be COOH and outside the instant compounds used in microcapsules with heat absorbers and optionally radical initiators. In Yanaka et al see particularly diitaconates and [0024,0025, 0032, 0035, 0057, 0058, 0077-0080].

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*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 0661.*



**CYNTHIA HAMILTON**  
**PRIMARY EXAMINER**

Cynthia Hamilton  
Primary Examiner  
Art Unit 1752

November 30, 2003